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IN THE

Supreme Court of the United States

OCTOBER TERM, 1962

NO. 806

BATESVILLE CASKET COMPANY, INC.,
Petitioner,

v.

JACWIL MFRS.,
Respondent

BRIEF FOR RESPONDENT IN OPPOSITION

PATRICK H. HUME,
CLYDE F. WILLIAN,
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TWENTIETH CENTURY PRESS, INC., CHICAGO 6

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No. 806

BATESVILLE CASKET COMPANY, INC.,
Petitioner,

v.

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ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE SEVENTH CIRCUIT

BRIEF FOR RESPONDENT IN OPPOSITION

OPINIONS BELOW AND JURISDICTION

Respondent adopts the allegations of the Petition (pp. 1-2) under these headings, but notes that the Opinion of the United States Court of Appeals for the Seventh Circuit (Pet. App. A) is also reported at 311 F.2d 38. The findings of fact and conclusions of law, entered without Opinion by the District Court (Pet. App. B.; R. 287-297)[1], are unreported.

1. "R." refers to the printed record below for use by the Appellate Court that comprises plaintiff-appellant's appendix unless otherwise indicated.

PETITIONER'S QUESTIONS PRESENTED

At the outset, respondent denies that this case presents any question that merits the attention of this Court, as will appear below.

Each of the first four questions presented in the Petition (pp. 2-3) is directed to the Doctrine of Equivalency in determining infringement of patent claims, in an obvious attempt to bring this case under the *Graver Tank & Mfg. Co.* v. *Linde Air Products*, 339 U. S. 605, precedent of this Court. However, the Court below reversed on file wrapper estoppel, the Trial Court's holding of infringement. The rationale of file wrapper estoppel excludes equivalency according to the settled law of this Court, and so excludes the possibility of conflict with the *Graver* case.

Questions 5 and 6 apparently deal with estoppel, but the fifth question is so involved and hypothetical as to be unintelligible as to its applicability to the present case, and of no possible interest beyond petitioner's private concerns. As to the sixth and final question, there are no known conflicts with prior decisions of this Court, the *Graver* case being inapposite for reasons noted, while other decisions of the Court, noted below, expressly approve both the rationale and the action taken by the Seventh Circuit Court of Appeals in this instance.

In petitioner's argument (Pet. p.8) *Spaulding Bros.* v. *John Wanamaker*, 256 F. 530, 533, is cited to show apparent conflict between the Seventh and Second Circuits in this matter of estoppel. There, Judge Learned Hand admonished not to regard an applicant's arguments to the Examiner in evaluating file wrapper estoppel. But the present decision of the Court below did not turn on such representations, rather on the specifications of two of peti-

tioner's patents, the drawings, and the claims presented for consideration, some of which were patented, others of which were canceled. These are the settled standards to evalue file wrapper estoppel laid down by this Court, that are followed by the Second Circuit Court of Appeals, as well as every other Court in the land.

Petitioner's questions are, therefore, without merit.

PETITIONER'S STATEMENT OF THE CASE

Respondent accepts the statement of the case set forth in the first two paragraphs under this heading (Pet. pp. 3-4), but rejects the remainder as being argumentative, conclusory, and misrepresentative: e.g., the primary issue of the case was the application of the doctrine of estoppel in suppression of the equivalency doctrine for reasons already stated.

STATEMENT

Respondent was declaratory judgment plaintiff and counterclaim defendant in a suit involving the infringement and validity of petitioner's U. S. Patent to Hillenbrand and Laugle, No. 2,664,615 (R. 302-314) relating to a casket interior unit made out of cardboard in simulation of, and as a substitute for, the upholstered interior previously applied to this purpose. Cardboard liners for coffin lids were not new, but had appeared in the prior art, e.g., Bowler Patent No. 2,181,504, (R. 315 *et seq.*). Petitioner asserted infringement by respondent, and respondent brought its suit for declaratory judgment. Petitioner answered and counterclaimed that respondent infringed. Issue was joined on the counterclaim respecting the infringement and validity questions.

The issues are the ordinary ones involving validity and infringement that attend all patent cases. No unusual, un-

settled, conflicting, or important public interest issues are presented for the consideration of this Court. The writ is a thinly veiled attempt by petitioner to further its private ends by asking this Court to review that which has been fully briefed and argued below, to reverse, and to hold respondent to account for infringement.

The equivalency doctrine of the *Graver* case is not applicable as asserted by the Petition, whereby the Opinion of the Court below is not in conflict therewith.

Firstly, the Court below turned its reversal upon file wrapper estoppel[*] in denying the equivalency upon which the District Court found infringement, whereby conflict with the *Graver* decision was not only absent, but the decision aligned with the settled law of this Court relative to file wrapper estoppel:

> *Schriber-Schroth Co.* v. *Cleveland Trust Co.*, 311 U.S 211, 218, 220-221, and
>
> *Exhibit Supply Co.* v. *Ace Patents Corp.*, 315 U.S. 126, 136-137,

and cases cited therein.

With respect to the limiting effect upon the doctrine of equivalents, imposed by that of file wrapper estoppel, attention is invited to the following cases that are a repre-

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[*] "For reasons to be discussed, we hold that the scope of the claims of the two Hillenbrand patents is limited by their prosecution history and hence finding of fact 19 is clearly erroneous. Thus limited the patent claims cannot be expanded by the doctrine of equivalents so as to embrace those particulars excluded by the prosecutional history of the patent. *Lewis* v. *Arco Manufacturing Corp.*, 228 F.2d 919 (7th Cir. 1956). Of necessity, finding of fact 20, flowing from an erroneous application of the doctrine of equivalents, must also fail as being clearly erroneous." (Opinion, Pet. App. A, pp. 5a-6a).

sentative sampling from several of the appellate circuit courts, most of which were decided long after the *Graver* case decision was announced by this Court in 1950:

> *Doran Coffee Roasting* v. *Wyott Mfg.* (10 Cir. 1959) 267 F.2d 200, 203
>
> *Dixie Cup* v. *Paper Container Mfg.* (7 Cir. 1948) 169 F.2d 645, 648
>
> *Carter Products, Inc* v. *Colgate Palmolive Co.*, (D.C. Md. 1958) 164 F.Supp. 503, 518; affirmed 269 F.2d 299, 304 (4 Cir. 1959)
>
> *McGraw-Edison* v. *Central Transformer* (D.C. Ark. 1961) 196 F. Supp. 664, 671, affirmed 305 F.2d 70 (5 Cir. 1962).

Secondly, in *Graver*, the Court found Rule 52(a), F.R.C.P. controlling where equivalency had been found on extensive expert testimony directed to complicated scientific and chemical phenomena. Here, only simple cardboard forms, and the most elemental mechanical considerations apply. Secondly, it was clearly stated in *Graver* that the area of equivalence may vary under the circumstances (p. 608). There could scarcely be conceived two more antipodal areas than those of the complex chemical *Graver* case and the simplex mechanical case at bar, involving nothing more complicated than cardboard forms for use in decorating the interior of lids of burial caskets.

Extension of equivalency to the simple cardboard forms involved would not only go contrary to the patentees' posture throughout the record, but would contravene the public welfare doctrine as expressed by this Court in *Sontag Chain Stores Co.* v. *National Nut Co.*, 310 U.S. 281, 293. Not what might have been claimed but what was claimed is that upon which the public is entitled to rely.

Thirdly, it is further evident that the Court below was

motivated in its application of the doctrine of file wrapper estoppel in delimiting equivalency to preserve the validity of the patent in suit as a matter of law.

The Appellate Court's action in putting aside the District Court's findings against the admonition of Rule 52(a) F.R.C.P., has been approved by this Court on numerous occasions:

> "A finding is 'clearly erroneous' when although there is evidence to support it, the reviewing Court on the entire evidence is left with the definite and firm conviction that a mistake has been committed." *United States* v. *U. S. Gypsum Co.*, 333 U.S. 364, 395, cited with approval in *Commissioner of Internal Revenue* v. *Duberstein*, 363 U.S. 278, 291 (1960).

This fits the present situation. On no possible ground is this case worthy of the Court's consideration.

CONCLUSION

The writ should be denied.

Respectfully submitted,

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* Again, to classify as an equivalent a feature that is designed to permit flexibility in the accused insert and which lacks any of the attributes called for by the patented insert, save for final appearance which we have already said was not patented, would grant to the patentee a monopoly over casket lid inserts not anticipated by the Patent Office and would seriously call into question the validity of the patent in light of the file wrapper history already discussed (Opinion, Pet. App. A. p. 11a).